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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,861	12/28/2000	Brad A. Davis	BEA9-2000-0015-US1	1468

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EXAMINER	
PORTKA, GARY J	
ART UNIT	**PAPER NUMBER**
2188	

MAIL DATE	DELIVERY MODE
02/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/752,861	DAVIS ET AL.	
	Examiner	Art Unit	
	Gary J. Portka	2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 16-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☒ Claim(s) *13 and 16-30* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-3, 6-16, 18-20, 22, 25-26, and 28-55 have been amended by Applicant. Claims 1-56 are pending.

Response to Arguments

2. Applicant's arguments filed February 21, 2007 have been fully considered but they are not persuasive. Applicants have argued that the term "native code" as used by the Venkatranman reference is not equivalent to the term as used in the present invention because there is no justification for assuming that a disk drive as used therein is anything other than a conventional drive which would require a protocol translation in a controller. Examiner disagrees; on the contrary, the processor is disclosed as executing "device-native code", so an artisan would assume that this code is native to the device and thus that no translation would be required. "Device-native" refers to device 10, this device possibly including (as pointed out by Applicant) disk drive at 210, plus media actuation hardware such as motors and heads (as previously cited at col. 10). Since the processor executes code that is native to device 10 (and thus all of its elements), there is no protocol conversion required to interface the code with the device, including to the disk drive and actuation hardware; otherwise the code would not be native to the device. Applicants have argued that the Nevill reference does not disclose loading to capacity. Examiner does not agree that such an explicit disclosure is required for an artisan to appreciate that the cache therein will be loaded to capacity; it would be wasting that resource and reducing the performance of the device if the

cache was not used to its fullest capacity, and thus provides a teaching to do the same in other systems

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18-21, 50-53, and 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 18 and 50 recite that a user interaction defining a data transfer to be executed indicates less likeliness to receive a mechanical shock. It is not clear that this is disclosed (support?), or whether it is shown how less likeliness to receive a mechanical shock may be predicted, and the means by which it is done. Claims 19-21, 51-53, and 56 incorporate the limitations of their independent claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-17, 22-49, and 54-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Venkatraman et al., US 6,139,177.

7. As to claims 1 and 33, Venkatraman discloses in a device configured for and method for providing access by a user, an assembly comprising an electromechanical digital data storage arrangement configured for operation responsive to a native control code, and a processing arrangement which executes a control program for controlling the overall device and which executes at least a portion of the native control code as part of the control program for use in directly interfacing with the storage arrangement with no intervening protocol layers (see Abstract, Figs. 1, 8, and 9, col. 3 lines 11-13, col. 4 lines 18-20 and 30-32, col. 9 lines 40-46, col. 9 line 60 to col. 10 line 7, col. 10 lines 28-36, and col. 11 lines 27-42).

8. As to claim 2, the device is disclosed as portable (see col. 10 lines 57-58).

9. As to claims 3-8 and 34-35, the arrangement includes rotatable media and motor arrangement, starting and stopping rotation and controlling movement of a sensing arrangement thereof ("media actuation") using the native code, and includes optical and magnetic media (see col. 10 lines 28-36 and 63-65).

10. As to claims 9, 15, 16, 36, 48, 49, the control responsive to user interaction is disclosed (see Abstract).

11. As to claims 10-14, 17, 22-31, 37-39, 40-47, and 54-55, since the recited time periods, user interactions and portions thereof, control events and series thereof, and

defined data transfers may be defined as desired from times, user interactions, and events of the disclosed system, the recited relationships are inherently disclosed.

12. As to claim 32, the storage arrangement not intended for physical access thereto is disclosed (since no intention of physical access was disclosed).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 18-21, 50-53, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman et al., US 6,139,177, in view of Nevill, US 6,910,206 B1.

15. As to claims 18-19, and 50-52, Venkatraman does not disclose the recited electronic memory arrangement loaded to capacity. However, such an arrangement is met by a cache, which is a well known arrangement that improves access speed by storing often used or expected-to-be used data in a faster memory (see Nevill, Fig. 1 and col. 4 lines 45-49). An artisan would have desired the better performance taught by Nevill and thus would have been motivated to use the same arrangement in Venkatraman. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to use the recited electronic memory arrangement, loaded to capacity, because this would maximize the performance in Venkatraman.

16. As to claims 20-21, 53, and 56, the storage device reading audio information is disclosed (see Venkatraman col. 10 lines 28-32).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary J. Portka whose telephone number is (571) 272-4211. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gary J Portka
Primary Examiner
Art Unit 2188

May 5, 2007

GARY PORTKA
PRIMARY EXAMINER